draws a false distinction, and Solo's pleadings in this case offer nothing beyond (and in fact less than) those in the prior Federal Circuit cases. A.246-48.

III. THE ISSUE PRESENTED IS IMPORTANT AND WARRANTS CORRECTION BY THIS COURT

Solo dismissively argues that a "dispute about the proper procedure" for addressing attorneys' fees "is not worthy" of this Court's review. Opp. at 4. For one, this case is not about attorneys' fees, it is about whether acts and events that create definitive mootness can only occur before a verdict and, as applied to the facts of this case, whether the Covenant tendered after the verdict mooted the controversy as to Solo's counterclaim seeking a declaratory judgment that Fort James's now-expired patent is unenforceable. Regardless, this Court frequently addresses the "proper procedures" that must be followed in the federal courts.

For example recently in *Unitherm Food Systems, Inc. v. Swift-Eckrich, Inc.*, 126 S. Ct. 980, 987 (2006), this Court held that the defendant's "failure to comply with Rule 50(b) forecloses its challenge to the sufficiency of the evidence." While there was no dispute in *Unitherm* that the defendant had the abstract "right" to seek post-verdict review, that right had to be availed within and not without the federal rules.

The present case is similar. Though Solo certainly had the "right" under 35 U.S.C. § 285 to move for attorneys' fees under Fed. R. Civ. P. 54(d)(2), Solo did not do so (though it knew to make a timely request for costs under Fed. R. Civ. P. 54(d)(1)) A.85-86. Contrary to Solo's arguments, Opp. at 7, a declaratory judgment count is not a substitute or "alternative" basis to seek fees. A proper and timely motion for fees under Rule 54(d)(2) is always required when fees are sought under § 285. *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1386 (Fed. Cir. 2005) ("No provision in

section 285 exempts requests for attorney fees thereunder from compliance with Rule 54(d)(2)(B)."). Solo's failure to move for attorneys' fees as required does not allow a fictional coercive claim for attorneys' fees to spring out of a moot declaratory judgment count with some potential factual overlap.

Moreover, cases where an accused infringer seeks a declaration of unenforceability and makes a prayer for attorneys' fees are more the rule than the exception. Counterclaims seeking a declaration that the patentee has conducted inequitable conduct are so common that the Federal Circuit has described them as a "plague." *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1482 (Fed. Cir. 1998). And it is a matter of course in such counterclaims to make a prayer for attorneys' fees under § 285. As Solo has recast the issue—that simply including a prayer for attorneys' fees creates sufficient controversy that such counterclaims may never be rendered moot, Opp. at 9—the case or controversy requirement under the Declaratory Judgment Act and Article III of the Constitution is itself made a nullity in any such case, that is, in what must be most patent cases in the federal courts.

CONCLUSION

For the foregoing reasons, as well as those set forth in the petition, this Court should grant the petition, and either summarily reverse the decision below or set the case for review.

Respectfully submitted,

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